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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,439

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Rainer Angenendt

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EXAMINER

LOEWE, ROBERT S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

10/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,439	Applicant(s) ANGENENDT, RAINER	
	Examiner ROBERT LOEWE	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-30 is/are pending in the application.
- 4a) Of the above claim(s) 24-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-23 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/27/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

Applicants traverse the election/restriction requirement mailed on 7/31/09 arguing that US Pat. 4,031,059 (Strauss et al.) does not teach the special technical feature linking all of the claims. Applicants argue that the special technical feature is a paste containing small mineral hollow microspheres, water, an inorganic/organic binder or a mixture of such binders and fibers, wherein the paste is freely shapeable, and is curable by drying at room temperature under normal pressure. However, all of the Groups do not share this alleged special common technical feature, at least because Group III does not require that the paste is freely shapeable or that it is curable by drying at room temperature under normal pressure.

Further, claims 1 and 2 and the list of components of the composition in column 16 of Strauss et al. anticipates at least claim 26 of the instant application. Evidence of lack of unity between groups I, II and III is found in, for example, wherein it is found to disclose the features of at least instant claim 26. As such, the special technical features of the claimed invention are not found to define a contribution over the prior art under PCT Rule 13.2.

The requirement is still deemed proper and is therefore made FINAL.

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Claim Objections

Claim 20 is objected to because the limitation "differently" is awkward language and should be replaced with --different--.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is unclear whether the limitation "inorganic/organic binder" relates to a binder which may either be inorganic or organic or whether the binder is a mixture of an inorganic and organic binder. Appropriate correction is required.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is unclear how microspheres may have an average grain size on the order of tens to hundreds of millimeters; that is to say the claimed grain sizes do not read on the limitation "microspheres". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-17, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Dietlein et al. (US Pat. 4,719,251).

Dietlein et al. teaches a trowelable silicone water base fire barrier composition (that is to say, it is freely shapeable, which cures upon drying at ambient temperature to an elastomeric film (2:15-16), which given its end use as a trowelable composition would be used and cured in normal pressure environments. The composition comprises water, silicone binder, hollow glass spheres having an average diameter of from 20 to 130 microns, and fibers (Sample 2 of table 4). Sample 2 of table 4 also comprises an antifoam, since the emulsion which is used in sample 2 is the same emulsion used in comparative example 1, which is taught to include an antifoam. While Dietlein et al. does not explicitly teach the addition of a wetting agent, Applicants own specification never cites a single example of a suitable wetting agent, even in the most generic sense. The compositions of Dietlein et al. include water and a hydroxyl endblocked liquid polydimethylsiloxane, which inherently serve as wetting agents.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dietlein et al. (US Pat. 4,719,251) as applied to claim 15 above, and further in view of Leroux et al. (US Pat. 5,262,454).

Dietlein et al. teaches the curable paste of instant claim 15, as described above. While Dietlein et al. does not explicitly teach that the hollow glass balloons employed in the working examples further include an inert gas, such a requirement to the hollow glass balloons is obvious given the teachings of Leroux et al. Dietlein et al. and Leroux et al. are combinable because they are from the same field of endeavor, namely silicone-based flame-resistant compositions comprising hollow glass balloons. At the time of the invention, a person having ordinary skill in the art would have found it obvious to employ glass microballoons as taught by Dietlein et al. which further comprises an inert gas as taught by Leroux et al. and would have been motivated to do so since Leroux et al. teaches that it is advantageous to employ glass balloons which are filled with a non-combustible gas/inert gas so that the gas filler does not in any way contribute to any possible burning (2:1-5).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dietlein et al. (US Pat. 4,719,251) as applied to claim 15 above, and further in view of Crompton et al. (4,879,066).

Dietlein et al. teaches the curable paste of instant claim 15, as described above. While Dietlein et al. does not explicitly teach that a mixture of hollow microspheres may be employed which have different melting points, this concept is known in the art as taught by Crompton et al. Dietlein et al. and Crompton et al. are combinable because they are from the same technical

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difficulty, namely, production of fire-resistant compositions. Crompton et al. teaches fire-resistant additives which are comprised of a mixture of two or more glass frits which have different melting temperatures. Crompton et al. teaches that employment of such a mixture of glass frits allows for the glass frits to melt progressively providing a fused protective layer (1:61-2:10). Since Dietlein et al. is concerned with fire barrier compositions, employment of a mixture of microballoons with different melt temperatures would be expected to yield fire barrier compositions which also display an enhanced fireproofing effect when compared with employing glass microballoon of a single type.

Potential Allowable Subject Matter

Should Applicants overcome the 112, second paragraph rejection of claims 15-23, instant claim 23 would be objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Specifically, none of the art of record teaches or fairly suggests the curable paste of instant claim 23, which consists of the claimed ingredients and claimed amounts of instant claim 23.

Relevant Art Cited

The prior art made of record and not relied upon but is considered pertinent to applicants disclosure can be found on the attached PTO-892 form.

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Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 273-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./
Examiner, Art Unit 1796
15-Oct-09

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796